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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,998	10/19/2001	Reinhard Lorenz	IN-12095	9873

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EXAMINER	
SERGENT, RABON A	

ART UNIT	PAPER NUMBER
1711	5

DATE MAILED: 09/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
10/019,998	Lorenz et al.
Examiner	**Art Unit**
Rabon Sergent	1711

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *three* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on _____.

2a) This action is **FINAL**. 2b) X This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) X Claim(s) *1-8* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) X Claim(s) *1-4 and 8* is/are rejected.

7) X Claim(s) *5-7* is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) X Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) X All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. X Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) X Notice of References Cited (PTO-892)	4) Interview Summary (PTO-413) Paper No(s).
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) Notice of Informal Patent Application (PTO-152)
3) X Information Disclosure Statement(s) (PTO-1449) Paper No(s). *1*	6) Other:

1. Claims 5-7 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. Also, claims 6 and 7 do not refer to the claims in the alternative; referring to any one of the processes is not equivalent to referring to any one of the claims. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Despite the language of claim 7, claim 6 is not directed to a process.

2. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language of claim 1 is indefinite, because it cannot be determined which reaction is being referred to within line 6 of the claim. It is unclear if "reaction" refers to the urethane forming reaction or the alkoxylation reaction, used to produce the polyether.

3. Claims 1-4 and 8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have failed to define or clearly disclose, within the context of the invention, what is meant by "electrically neutral".

4. Claims 1-4 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, the language, "selected from among", within the definitions of M and X, is improper Markush language. Markush groups, by definition, are closed to the addition of other species; however, "among" suggests that the group encompasses unnamed species.

Secondly, applicants have failed to define, "s", within the subscript of the last species of X within claims 1 and 8.

5. Claims 2-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, it is improper to specify NH_4^+ within the definition of M, because it isn't a metal and the Markush group of claim 1 doesn't provide for it.

Secondly, within the definition of X, the Markush group of claim 1 doesn't provide for the following species: SO_4^{2-} and $(C_{n+1}H_{2n-2}O_4)^{2-}$.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Reisch et al. ('038 or '681).

Patentees disclose that the addition of metal compounds, such as alkali metal alkoxides and alkaline earth metal alkoxides, to polyether polyols, derived from methods utilizing double metal cyanide catalysts, improves the reactivity of the polyether polyols when reacted with isocyanates to yield polyurethanes. See abstract; column 2; and claims.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reisch et al. ('038 or '681).

As aforementioned, patentees disclose that the addition of metal compounds, such as alkali metal alkoxides and alkaline earth metal alkoxides, to polyether polyols, derived from methods utilizing double metal cyanide catalysts, improves the reactivity of the polyether polyols when reacted with isocyanates to yield polyurethanes.

9. Patentees fail to specifically teach that the metal compound may be mixed with the polyisocyanate component; however, patentees do teach within the paragraph bridging columns 4 and 5 that the order of mixing is not important as long as components do not react undesirably before all components are present. In view of this disclosure, the position is taken that one of ordinary skill in the art would have found it obvious to add the metal compound at any point or to any component prior to reaction. Applicants have failed to provide any showing of criticalness attributable to mixing the metal compound with the polyisocyanate .

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

RABON SERGENT
PRIMARY EXAMINER

R. Sergent

September 19, 2002